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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,067	11/19/2003	Chhman Sukhna	P/1281-121	7234

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/717,067

Applicant(s)

SUKHNA, CHHMAN

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-21 and 23-25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicant's amendment filed 4/21/06 has been fully considered but the amendment has not been entered given that the amendment raises new issues that would require further consideration and/or search.

Specifically, applicant has amended each of claims 1 and 23 to recite that the ink does not contain titanium dioxide. Such amendment would require further search given that previously, in light of the open language of the present claims, i.e. ink "comprising", the claims were open to the inclusion of additional ingredients in the ink including titanium dioxide. However, given that titanium dioxide is now excluded from the scope of the present claims, new searches would be required. Further, claim 23 has been amended to recite that the marking instrument is "selected from among wick style and free ink system writing instruments". Such amendment would also raise new issues that would require further search given that previously the scope of claim 23 encompassed any type of marking instrument (comprising nib and reservoir) while now the claims are limited to marking instrument "selected from among wick style and free ink system writing instruments".

Additionally, the amendment would raise new issues that would require further consideration under 35 USC 112, second paragraph. Claim 23 recites an improper Markush group given that the claim has been amended to recite that the marking instrument is "selected from among wick style and free ink system writing instruments". In order to recite proper Markush group, the claim should recite, for instance, (i) "selected from the group consisting of wick style and free ink system writing instruments" or (ii) "selected from among wick style or free ink system writing instruments".

It is noted that even *if* the amendment were entered, the amendment would not overcome the rejections of record set forth in paragraphs 11-15 of the office action mailed 2/1/06, namely, (i) Loria et al. (U.S. 4,880,465) in view of Takemoto et al. (U.S. 6,827,433) and further in view of Imagawa et al. (U.S. 5,716,217), Beach et al. (U.S. 6,309,452), and Pearlstine et al. (U.S. 6,087,416) and (ii) Imagawa et al. in view of Loftin (U.S. 5,338,793) and Tanaka et al. (U.S. 2003/0228430).

Applicant argues that Loria et al. and Imagawa et al. are no longer relevant references against the present claims given that Loria et al. is drawn to ink jet ink and Imagawa et al. is drawn to ink for use on neon boards or lighted boards which is in direct contrast to the present claims that require ink “adapted for use in at least one of wick style and free ink system writing instrument”.

However, while it is agreed that Loria et al. is drawn to ink jet ink and Imagawa et al. is drawn to ink for neon boards or lighted boards, the requirement in the present claims that the ink is “adapted for use in at least one of wick style and free ink system writing instrument” is merely intended use. As set forth in MPEP 2111.04, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed or by claim language that does not limit a claim to a particular structure. Such claim language includes “adapted for” language. Given that the use of “adapted for” simply expresses the intended use of the ink, it is the examiner’s position that each of Loria et al. and Imagawa et al. would remain a relevant reference against the present claims. Further, attention is drawn to MPEP 211.02, which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural

difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Loria et al. in combination with Takemoto et al. and Imagawa et al. in combination with Loftin et al. disclose ink as presently claimed, it is clear that such inks would be capable of performing the intended use, i.e. for use in at least one of wick style and free ink system writing instrument, presently claimed as required in the above cited portion of the MPEP.

Applicant also argues that there is no disclosure in Loria et al. of dimethicone copolyols and that such dimethicone copolyols are not necessary in the ink of Loria et al. given that the ink of Loria et al. is not used in wick style and free ink system writing implements and thus, it is not subject to the settling problems that occur in applicant's ink.

It is agreed that there is no disclosure in Loria et al. of dimethicone copolyols which is why Loria et al. is used in combination with Takemoto et al. which is drawn to ink jet ink as is Loria et al. and which discloses the use of dimethicone copolyols in order to produce ink that can realize good image on paper, i.e. does not cause color bleed or uneven printing.

Although this is a different motivation for using dimethicone copolyol than in the present invention, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicant also argues that ink jet inks as disclosed by Loria et al. have completely different requirements than the inks of the present invention. Applicant notes that the ink jet inks of Loria et al. need certain resistivity that is not necessary for the present claimed inks.

However, which such resistivity may not be necessary for the presently claimed ink, there is no evidence that ink possessing such property would not be capable of use in wick style and free ink system writing implements. That is, given that Loria et al. in combination with Takemoto et al. disclose ink as presently claimed, and absent evidence to the contrary, it is the examiner's position that such ink would be capable of performing the intended use, i.e. for use in wick style and free ink system writing implements.

Applicant argues that there is no disclosure in Takemoto et al. of hollow microspheres..

While it is agreed that there is no disclosure of hollow microspheres in Takemoto et al., note that Takemoto et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of dimethicone copolyol in ink in order to produce ink that can realize good image on paper, and in combination with the primary reference, discloses the presently claimed invention.

Applicant argues that Beach et al. is not a relevant reference against the present claims given that Beach et al. refers to printing inks that require wet-rub resistance that is not required

with the presently claimed ink and given that there is no disclosure in Beach et al. of dimethicone copolyol.

However, there is nothing in the present claims that excludes the ink from having wet rub resistance or any evidence that ink possessing such property would not be capable of performing the intended use, i.e. for use in wick style and free ink system writing implements. Further, while there is no disclosure in Beach et al. of dimethicone copolyol, note that Beach et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of glycol humectant in ink jet inks, as disclosed by Loria et al., and in combination with the primary reference, discloses the presently claimed invention.

Applicant also argues that Beach et al. is not a relevant reference against the present claims given that Beach et al. apply heat and pressure to cure the ink onto substrate, which is not required in the present invention. However, it is noted that the application of heat and pressure to the printed ink is not required in Beach et al. While one embodiment of Beach et al. discloses using heat and pressure to cure the ink, it is not required in all embodiments.

Applicant argues Pearlstine et al. is not a relevant reference against the present claims given that there is no disclosure of hollow microspheres in Pearlstine et al. However, it is noted that Pearlstine et al. is a teaching reference, and therefore, it is not necessary for this secondary references to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d

965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this references teaches a certain concept, namely, the use of fluorocarbon surfactants in inks, and in combination with the primary reference, discloses the presently claimed invention.

Applicant also argues that the fluorosurfactant used in Pearlstine et al. is used to provide wetness and not to suspend colored pigment. Although the motivation to combine disclosed by Pearlstine et al. is not the same motivation as in the present invention, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicant also argues that Imagawa et al. is not a relevant reference against the present claims given that the ink of Imagawa et al. comprises carboxylic acid ester and further given that there is no mention in Imagawa et al. of a need to suspend or prevent the hollow microsphere present in the ink from settling and no disclosure of dimethicone copolyol and submicron polymeric particles that cohesively bond to another to provide a substantially homogeneous non-settling ink.

While it is agreed that Imagawa et al. requires the use of carboxylic acid ester not required in the present claims, it is noted that in light of the open language of the present claims, i.e. "comprising", the use of such carboxylic acid ester is clearly not excluded from the scope of the present claims.

Further, although there is no disclosure in Imagawa et al. that the dimethicone copolyol and hollow microspheres are cohesively bonded to each other to provide a substantially homogeneous non-settling ink, given that Imagawa et al in combination with Loftin disclose dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would intrinsically cohesively bond to another to provide a substantially homogeneous non-settling ink.

Applicant also argues that there is no motivation to utilize dimethicone copolyol in Imagawa et al. given that Imagawa et al. already teaches the use of hollow microspheres that will not coagulate or settle.

However, while Imagawa et al. disclose that the hollow microspheres will not settle, it is noted that the motivation for using dimethicone disclosed by Loftin to wet substrate and improve erasability of the ink. Although the motivation to combine is not the same motivation for using dimethicone copolyol in the present invention, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

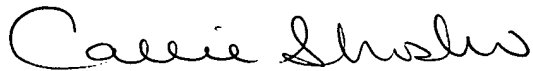
Applicant argues that Tanaka et al. is not a relevant reference against the present claims given that Tanaka et al. is drawn to thermal transfer printing and has no relationship to markers and/or writing instruments.

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It is agreed that Tanaka et al. is drawn to thermal printing and not ink for markers. However, Tanaka et al. is only used to teach the meaning of a specific tradename already disclosed by Imagawa et al., namely, OP-84J.

Thus, even *if* the amendment were entered, present claims 1-21 and 24-25 would not be allowable over the prior art of record as discussed above.

It is noted, however, that *if* the amendment were entered, claim 23 would be allowable over the prior art of record given that there is no disclosure in the "closest" prior art Loria et al. (U.S. 4,880,465) or Imagawa et al. (U.S. 5,338,793) of marking instrument selected from among wick style and free ink system as required in present claim 23.


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Primary Examiner
Art Unit 1714

CS
5/8/06